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10/535,408

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EXAMINER

NGUYEN, TRAN N

ART UNIT

PAPER NUMBER

3626

NOTIFICATION DATE

DELIVERY MODE

05/26/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/535,408 | Applicant(s) MOCHIDA, NAOYUKI | |
| | Examiner Tran Nguyen | Art Unit 3626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-25 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>09/03/2009, 1029/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

As per the Office Action mailed 04/03/2009:

All objections and rejections with respect to claims 1-10 are hereby withdrawn in view of Applicant's cancellation of these claims.

Election/Restrictions

Applicant's election with traverse of Group I, claims 11-19, 21-25 in the reply filed on 04/12/2010 is acknowledged. The traversal is on the following ground(s):

Applicants submit that
the Examiner has failed to specifically describe the unique special technical feature in each group
to explain why each group lacks unity with each other group, as specified in requirement (2)

above. Instead, the Examiner merely states that "the common technical feature in all groups is the user authenticator and the application server searcher", and then asserts that these elements are not a special technical feature because they are shown in the prior art of U.S. Patent 5,867,494 to KRISNASWAMY.

Applicant respectfully traverses the Examiner's assertion that the above-noted features are shown in KRISNASWAMY, and thus, are not a common technical feature. M.P.E.P. §1893.03(d) specifies that a group of inventions will be considered to be linked to form a single inventive concept where there is a technical relationship among the inventions that involves at least one (emphasis added) common corresponding special technical feature.

As argued at pages 12-14 in the Response Under 37 C.F.R. §1.111 filed on September 3, 2009, KRISNASWAMY fails to disclose (or even suggest) that a relay server apparatus (1) establishes a session between a client terminal and an application server to deliver a service to the client terminal, and (2) performs predetermined operations including receiving a session establishment request, authenticating the client terminal, searching an application server, relaying the session establishment request, relaying a response from the application server, and relaying a confirmation request from the client terminal. Applicant submits that it is at least these technical features that link the group of inventions identified by the Examiner, and result in the formation of a single inventive concept.

This is not found persuasive because:

Applicant argues that the applied art do not teach:

- (a) receiving a session establishment request;
- (b) relaying the session establishment request;
- (c) relaying a response from the application server;
- (d) relaying a confirmation request from the client terminal.

At least some of these features are not found in claim 20.

Therefore, at least some of these features cannot be the common technical features shared between Group I and Group II because at least some of these features do not appear in claim 20.

The remainder of Applicant's argument is moot because they are not directed at the common technical features.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claim(s) 20 drawn to a nonelected invention. A complete reply to the restriction must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Therefore, claim(s) 20 is/are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112, Fourth Paragraph

The following is a quotation of that portion of 35 U.S.C. 112 which forms the basis for rejections made under this section in this Office action:

A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.

Claim(s) 19 is/are rejected under 35 U.S.C. 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph), or, in other words, that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

When, as here, an independent claim recites a particular category of invention, a dependent claim directed towards a different category is not a proper dependent claim since the dependent claim could conceivably be infringed by mere possession of the invention of the dependent claim without possessing any part of the claimed invention in the independent claim. This is in violation of the infringement test for proper dependency of claims. See MPEP § 608.01(n)(III).

Applicant is required to cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In this case, claim 19 recites a manufacture while parent claim recites a server. Therefore, possession of the manufacture of claim 19 without any server structure at all would not infringe parent claim 1. This is an improper dependent claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-19, 21-25 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, this claim recites a “server” comprising a “requester”, “an authenticator”, a “searcher”, and a plurality of “relayer” limitations.

When read in light of the specification and the level of ordinary skill in the art, these limitations may be broadly interpreted to envelop software *per se* structure because Applicant has not positively recited any hardware structure.

For this reason, the claim is found to be directed towards nonstatutory subject matter.

All claims dependent thereon, namely claim(s) 12-17, 19, 21-25, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

As per claim 19, this claim recites a “computer readable medium”.

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer

readable media, particularly when the specification is silent. See MPEP 2111.01.

When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals per se, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter.

As per claim 18, based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively

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recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

This claim recites a method comprising a plurality of steps; however, none of the steps require any statutory machine. Therefore, the claim fails the “machine” prong of the test.

The “confirmation” request is considered to be mere data transformation at best, and do not amount to a physical transformation. Therefore, the claim fails the “transformation” prong of the test.

Since the claim fails both prongs of the “machine or transformation” test, this claim is found to be directed towards nonstatutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 11-12, 15-19, 21, 23-25 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Menschik (20050027995) in view of Edelson (5737539).

As per claim 11, Menschik teaches a system capable of facilitating (reads on "relay server") file transfer (reads on "service delivery") between a user computer (reads on "client terminal") , wherein the user computer connects to a central server (reads on "the session") (Figure 14) and then connecting directly to the source computer (reads on "an application session different from the session") to transfer or view a file (reads on "delivers a service directly to the client terminal") (Figure 16-17), comprising:

(a) software on the central server (reads on "a requester") capable of receiving a request from the user computer, wherein the request comprises data identifying a particular patient (reads on "service request information") (Figure 14);

(b) software on the central server (reads on "an authenticator") capable of registering and authenticating the user computer (Figure 12-13);

(c) software on the central server (reads on "a searcher") capable of searching a database representing source computers containing thereon data requested by the user computer (Figure 14);

(d) software on the central server (reads on "a service inquiry layer") capable of determining which source computer(s) containing the requested data (Figure 14).

Menschik does not explicitly teach contacting the source computer directly to inquire if the source computer can provide the requested data.

Edelson teaches that if a patient is not found in the indexed directory located at the central host computer, searching all remote computers directly to determine if any of these remote computers contain the requested data (column 8 line 50-54).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Edelson within the embodiment of Menschik with the motivation of providing data for patients not listed in the directory (Edelson; column 8 line 51-54).

Menschik further teaches:

(e) software (reads on "a response layer") capable of providing the source computer(s) containing the requested patient data to the user computer (Figure 14);

(f) software (reads on "a confirmation relay") capable of connecting the user computer directly to the source computer (Figure 15-16) (It is noted that the key and other data used to establish a direct connection is considered to be "a confirmation request").

As per claim 12, the user computer is capable of specifying which patient (reads on "client information") and whether to receive or view (reads on "service content") (Figure 14).

As per claim 15, this claim is rejected for substantially the same rationale as applied to claim 11 above, and incorporated herein.

In particular, Applicant has not defined the scope of “session change request including service change information”.

Additionally, the claimed system would function in the same manner regardless of the descriptive label attributed to the inputted data.

Indeed, the claim only requires that the system receives request data and queries a computer if the received request data may be accommodated. As such, the contents of the received request data do not materially affect the functionality of the claimed system, i.e. the claimed system would function in the same manner regardless of the type of request data received by the system. Regardless of the contents of the request data, the system simply queries a computer to determine if the computer can perform the requested data functions.

To the extent Applicant would argue that the applied art do not teach a particular claimed data, the distinction is a matter of the content of the information, that is, descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate (here the system). See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994). *In re Ngai*, 367 F.3d at 1338. See also, *Ex parte Mathias*, 191 Fed. Appx. 959 (CCPA 2006).

In that regard, Applicant has not come forward with evidence sufficient to show that the structure of the claimed system is functionally affected by the data inputs as in the applied art. Absent such evidence, it is reasonable to conclude that the claim limitations to generic data are descriptive and not functionally related to any structure of

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the claimed system and as such falls under the category of patentably inconsequential subject matter. See *Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative) (“Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.)” See also *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative).

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. In *re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. In *re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

As per claims 16-17, Menschik teaches that the system is capable of connecting to a plurality of source computers (Figure 16).

As per the set of claim(s): 18, 19, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 11, 11, respectively, and incorporated herein.

As per claim 21, Menschik teaches indicating an error when authentication fails (Figure 14) and when transfer fails (Figure 16-17).

As per claim 23, Menschik teaches requiring the user computer to obtain a key prior to accessing the source computer (Figure 16).

As per the set of claim(s): 24, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 13, respectively, and incorporated herein.

As per claim 25, Menschik teaches that any source computer can request documents for themselves (Abstract and throughout).

Similar rationale as applied to claim 15 also applies here, as discussed above and incorporated herein.

Claim(s) 13-14 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Menschik in view of Edelson as applied to parent claim 11 above, and further in view of Crowcroft (Differentiated end-to-end Internet services using a weighted proportional fair sharing TCP).

As per claim 13, Menschik teaches connecting to the source computer (Figure 15-16).

Menschik and Edelson do not teach receiving a disconnection signal and billing based on the connection duration.

Crowcroft teaches billing a user based on the duration of a connection (page 63 paragraph 1). It is noted that duration calculation suggests that a start time and a finish time are used to determine duration. This suggests the disconnection signal.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Crowcroft within the embodiment of Menschik and Edelson with the motivation charging the user for Internet usage (Crowcroft; page 62 Section 5).

As per claim 14, this claim is rejected for substantially the same rationale as applied to claim 13 above, and incorporated herein.

In particular, since all functionality are known, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the known functionality on any known computer without materially affect the functionality.

Claim(s) 22 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Menschik in view of Edelson as applied to parent claim 11 above, and further in view of Rodriguez (Parallel-Access for Mirror Sites in the Internet).

As per claim 22, Edelson in view of Menschik teaches searching a plurality of sites, as discussed above and incorporated herein.

Menschik and Edelson do not teach canceling a request when one source has been found.

Rodriguez teaches a plurality of computers hosting the same document (page 1 column 1 paragraph 2). Rodriguez further teaches shying away from slow computers towards a faster computer (page 1 column 2 paragraph 2).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Rodriguez within the embodiment of Menschik and Edelson with the motivation connecting to a fast server to complete the transfer.

Response to Arguments

Applicant's arguments filed 09/03/2009 have been fully considered but they are not persuasive.

On page 9 Applicant asserts:

Applicant notes that the Examiner has inadvertently failed to confirm the acceptability of the filed drawings. Absent an indication to the contrary in the next official communication, Applicant believes the filed drawings to be acceptable.

Since no objection was previously imposed, the drawings are presumed to be valid. Nevertheless, explicit indication has been provided herewith. See PTOL-326.

Applicant's remarks on page 9-11 regarding cited references have been fully considered.

See Form PTO-1449 attached herewith for indication of the considered references.

Applicant's arguments with respect to claim 11 on page 12-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The new ground(s) of rejection presented in this Office action, if any, was/were necessitated by Applicant's amendment. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald (Jerry) J O'Connor can be reached on 571-272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/T. N./

Examiner, Art Unit 3626

/Robert Morgan/

Primary Examiner, Art Unit 3626